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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/700,103 11/09/00 GERS-BARLAG

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EXAMINER

LAMM, M

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/700,103

Applicant(s)

GERS-BARLAG ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claims 1-6 are pending in this application filed 11/9/2000.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "as solvent, solubility promoter or solublizer", and the claim also recites "in particular, in light protection compositions", which is the narrower statement of the

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range/limitation. Further, claims 3 and 6 recites the broad recitation "is chosen from the range ...% by weight", and the claims also recite "preferably ...% by weight".

Claims 3 and 6 recite the limitation "in the finished cosmetic or dermatological preparations". There is insufficient antecedent basis for this limitation in the claims.

Claims 4 and 5 recite the limitation "the ester(s) of branched-chain carboxylic acids" in line 1. There is insufficient antecedent basis for this limitation in the claims because Claim 1 recites "unbranched-chain carboxylic acids".

Claim 4 recites the limitation "the parent alcohols R₂-OH". There is insufficient antecedent basis for this limitation in the claim.

Claim 5 is viewed as indefinite because it recites the limitation "the ester of branched-chain carboxylic acids and branched-chain alcohols **chosen** is hexyldecyl laurate". The claim language is confusing. For the purpose of the examination the quoted phrase was interpreted as follows: "the ester of branched-chain carboxylic acids and branched-chain alcohols is hexyldecyl laurate".

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 09/700,102 in view of Ascione et al. (US 5,605,678). The difference between the instant claims and those of '102 is that the instant claims recite a combination of a triazine derivative with esters of *unbranched*-chain carboxylic acids and branched-chain alcohols, while the claims of '102 recite a combination of the triazine derivative with esters of *branched*-chain carboxylic acids and branched-chain alcohols. However, both esters of branched and linear carboxylic acids and branched-chain alcohols are used interchangeably for the same art-recognized purpose, as cosmetic oils. See Ascione et al. at col. 2, lines 35-50. Therefore, the claimed invention and that of '102 are obvious over each other.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Lüder (WO 98/52526). Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ascione et al. (US 5,605,678).

Lüder teaches UV absorbent compositions comprising 3% of the triazine derivative of the instant invention (octyl triazone or Uvinul T-150) in combination with 2% of isopropyl myristate. See Example 4 on p. 9. Octyl triazone may be employed in amounts of from 0.5 to 15% by weight. See p. 3, lines 22-26.

Ascione et al. teach cosmetic sunscreen compositions containing a combination of the triazine derivative of the instant invention (Uvinul T-150) with at least one oil. See Abstract. The oils of Ascione et al. include esters of unbranched carboxylic acids and branched alcohols, such as di(2-ethylhexyl) adipate. See col. 2, lines 35-50; col. 3, lines 54-56. The triazine derivative is present at a concentration ranging from 0.1 to 10% by weight, and the ester is present at a concentration ranging from 0.5 to 50% by weight. See col. 3, lines 48-52; col. 4, lines 51-55.

The method of Claim 2 is inherent in references cited above. The esters of Lüder or Ascione et al. will inherently act as solvents, solubility promoters or solubilizers for the triazine derivative.

Thus, Lüder or Ascione et al. teach each and every limitation of Claims 1-3 and 6.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Ascione et al. or Lüder in view of Nguyen et al. (US 6,162,448).

Ascione et al. or Lüder applied as above.

Either Ascione et al. or Lüder does not explicitly teach hexyldecyl laurate of the instant claim.

However, hexyldecyl laurate is conventionally used for the same art-recognized purpose as the esters of Ascione et al. or Lüder, that is as a cosmetic oil. See Nguyen et al. at col. 11, line 11.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use hexyldecyl laurate in the compositions of Ascione et al. or Lüder for its art-recognized purpose. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lüder.

Lüder applied as above.

Lüder does not explicitly teach the presence of the parent alcohol as claimed in Claim 4. However, it is generally known to use isopropyl alcohol as a solvent in cosmetic compositions. Therefore, it would have been obvious to one having ordinary skill in the art at

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the time the claimed invention was made to use isopropyl alcohol in combination with isopropyl myristate in compositions of Lüder, for its art-recognized purpose.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

10. No claim is allowed at this time.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,096,294; US 6,207,140 and its PCT counterpart WO 98/15253; EP 800817.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml
6/8/01


JOSE G. DEES
SUPERVISORY PATENT EXAMINER
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